UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte LAWRENCE W. KREBS, WAYNE FULLER, and JOSEPH ABUSAMRA

Appeal No. 2005-2161
Application No. 09/110,661

ON BRIEF

Before BARRETT, RUGGIERO, and DIXON, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 2, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellants' invention relates to an ATM network management system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1. In an asynchronous transfer mode (ATM) management network, having the following functional areas: fault management, performance management, configuration management, security management and accounting management, the method of operating said ATM management network comprising:
>
> (a) using an inference engine fault manager including correlation of ATM switch failures and traps and automating recommend courses of corrective action, and
>
> (b) using an inference engine for said performance management of said ATM management network.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hearn et al. (Hearn)	5,640,505	Jun. 17, 1997

Appellants' Admitted Prior Art (AAPA)

Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hearn in view of AAPA.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the answer (mailed May 20, 2003) for the examiner's reasoning in support of the rejections, and to the brief (filed Feb. 27, 2003) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a ***prima facie*** case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A ***prima facie*** case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the

claimed subject matter is ***prima facie*** obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in

the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362,1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the language of independent claim 1 which recites "[i]n an asynchronous transfer mode (ATM) management network, . . .(a) using an inference engine fault manager including correlation of ATM switch failures and traps and automating recommend courses of corrective action, and (b) using an inference engine for said performance management of said ATM management network."

Appellants argue that neither Hearn nor the AAPA teach or fairly suggest the use of an "inference engine" for the recited fault management and performance management as recited in independent claim 1. (Brief at pages 4-8.) We agree with appellants and do not find that the examiner has established a ***prima facie*** case of obviousness of the claimed invention in the answer. The examiner relies upon the teaching of the use of rules in database 134 which are used in planning the network. (Answer at page 4.) While we agree with the examiner that Hearn does teach that rules are present in database 134, we find neither a teaching or suggestion within the four corners of Hearn nor a convincing line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention to use rules and an inference engine in either the fault manager or the performance management portions of the ATM. Hearn discloses that database 119 contains "the rules which defined the technology configurations to provide service from the database 119. Using this data, the service management system 120 determines the changes which need to be made to the network to provide the new service instance." (Hearn at col. 10, lines 33-38.) Hearn teaches that the network planning system 141 also uses the rules used in databases 119, 134, 144, and 180. (Hearn at col. 11, lines 63-64.) Hearn further discloses that "database 148 contains data relating to . . . and rules for restoring

service[s]." (Hearn at col. 12, lines 29-31.) The examiner states that the traffic manager 138 is an "interference engine" which we assume is a typographical error intended to be an "inference engine." The examiner concludes the answer with a statement of a definition of an "expert system" at pages 6-7 of the answer, but we find no line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention to have implemented such a system for the recited functional modules of Hearn.

Therefore, we cannot sustain the rejection of claim 1 nor its dependent claim 2, since the examiner has not met the initial burden of establishing a ***prima facie*** case of obviousness of the invention recited in the claim.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 2 under 35 U.S.C. § 103 is reversed.

REVERSED

LEE E. BARRETT
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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